

REMARKS

I. CLAIMS 1-4 AND 11-16 ARE NOT ANTICIPATED BY THE '434 PATENT TO SCALFANI ET AL.

The '434 Patent discloses a vacuum cleaner 10 having a nozzle 12 and an upper handle 14. A dirt cup assembly 30 is releasably mounted on the upper handle 14. The dirt cup assembly 30 includes a dirt cup 50 and a cyclonic filter assembly 52. This filter assembly 52 includes an inverted truncated cone 100 pivotally connected to a member 102 that includes a filter bag 104 extending upwardly from the member 102. The dirt cup 50 is formed with an open top 90 which receives the filter assembly 52.

In stark contrast, Applicant's claim 1 requires:

a filter assembly including a filter housing defining a filter chamber, *said filter housing and filter chamber mating with said open end of said dirt cup.*

As discussed during the telephone interview with the Examiner, nowhere does the '434 Patent teach or suggest a *filter housing and filter chamber* that mate with the open end of the dirt cup. Instead, it only discloses the filter assembly 52 mating with the open top 90 of the dirt cup 50. Since the filter assembly 52 is the only structure that mates with the open top 90 of the dirt cup 50, and this assembly 52 fails to include "a filter housing defining a filter chamber," claim 1 is not anticipated.

The Examiner does not disagree with this point, since she fails to provide any evidence whatsoever in the Action or telephone interview describing where the '434 Patent teaches both a filter housing and a filter chamber mating with the open end of the dirt cup. Accordingly, since the '434 Patent fails to teach each and every limitation of Applicant's claims, the rejections must be withdrawn. *See Lewmar Marine, Inc. v. Barient, Inc.*, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987) (finding that "[a]nticipation under 35 U.S.C. §102 requires the presence in a single prior art disclosure of each and every element of a claimed invention").

II. NO COMBINATION OF '434 PATENT TO SCALFANI ET AL. WITH THE '550 PATENT TO SONG RENDERS CLAIMS 1-16 OBVIOUS.

In order to establish a *prima facie* case of obviousness, all claim limitations must be taught or suggested by the cited references. See *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970) (finding that “[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art”). As discussed above, the ‘434 Patent fails to disclose teach or suggest a ***filter housing and filter chamber*** that mate with the open end of the dirt cup. The ‘550 Patent cited also fails to provide the requisite teachings. Instead, the ‘550 Patent teaches a “filter means” 5 positioned in the “dust collector” 3 with absolutely no discussion of “a filter housing defining a filter chamber,” as required by the claims. Accordingly, no combination of the ‘434 Patent with the ‘550 Patent teaches or suggests the limitations of the pending claims.

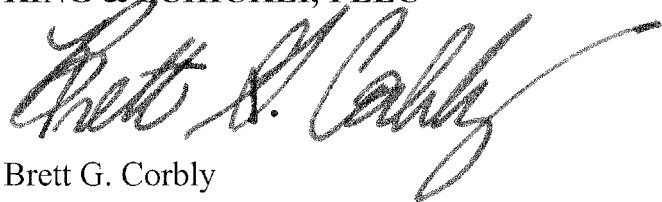
Even if the ‘434 and ‘550 Patents taught or suggested the limitations of the claims, there is absolutely no motivation to combine these references, as is required to establish a *prima facie* case of obvious. In particular, the U.S. Court of Appeals for the Federal Circuit states that, “**elements of separate prior patents cannot be combined when there is no suggestion of such combination anywhere in those patents.**” *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984) (emphasis added). Instead, ***objective evidence*** must be cited to support an assertion that there is a motivation to combine two references. *Teleflex, Inc. v. Ficosa North America Corp.*, 63 USPQ2d 1374, 1387 (Fed. Cir. 2002); *In re Dembiczak*, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). In this instance, the Examiner provides absolutely no ***objective evidence*** that shows a motivation or suggestion to combine the ‘550 Patent with the ‘434 Patent. Instead, the Examiner extracts individual elements of the ‘434 Patent and attempts to insert them into the ‘550 Patent, even though there is not a scintilla of support for such a combination.

Since neither the '550 nor the '434 Patent teach or suggest the limitations of the pending claims, and there is no motivation to combine these patents, claims 1-16 are not rendered obvious.

In view of the foregoing, Applicant respectfully requests a Notice of Allowance for claims 1-16. If any matters require further attention, the Examiner is requested to contact the Applicant's attorney at the telephone number below. The undersigned authorizes the deduction of any necessary fees from Deposit Account No. 11-0978.

Respectfully submitted,

KING & SCHICKLI, PLLC

A handwritten signature in black ink, appearing to read "Brett G. Corbly", with a long, sweeping horizontal stroke extending to the right.

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